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| 10/644,635      | 08/19/2003  | Gregory A. Piccionelli | 39003.809US01       | 7528             |

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| EXAMINER |
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GART, MATTHEW S

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| ART UNIT | PAPER NUMBER |
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3625

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 12/20/2006 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/644,635

Applicant(s)

PICCIONELLI ET AL.

Examiner

Matthew S. Gart

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/24/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Prosecution History Summary***

Claims 1-25 are pending in the instant application.

***Drawings***

The Examiner accepts the drawings filed on 8/19/2003.

***Response to Amendment***

The objections of claims 8 and 22 are vacated in view of the Applicant's amendment submitted on 10/24/2006.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner notes, the limitation "...by storing the information together with an identification of the performance in a storage medium independent of a medium used to transmit the performance..." is a negative limitation (i.e., storing information in a storage medium not the storage medium used to transmit the performance). This negative limitation does not have explicit bases in the original disclosure. Any negative limitation must have basis in the original disclosure. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by BayTSP (PTO-892, Ref U).**

Referring to claim 24. BayTSP discloses a method of producing a record of a performance, the performance being transmitted over a network, the performance being subject to a record-keeping requirement, the method comprising the steps of:

- i) providing information pertaining to a performance in accordance with a record-keeping requirement (BayTSP: page 8, "BayTSP.com's 2257 suite of products requires customers to submit personally identifiable information about adult entertainment performers in order to comply with federal recording keeping compliance regulations set forth by 18 U.S.C. 2257."),
- ii) associating the information with the performance (BayTSP: page 8, "BayTSP.com's 2257 products embed 2 forms of identification for each performer in each image.") by storing the information together with an identification of the performance in a storage medium independent of a medium used to transmit the performance (BayTSP: page 8, "...unless it is

a content owner with smart card access to the database where full identification card information is available.”),

- iii) providing the stored associated information to a custodian (BayTSP: page 12, “2257Custodian is a service for web masters who are required to comply with U.S. Code 2257 by maintaining compliance documentation for every performer depicted on a site containing sexually explicit material.”), and
- iv) providing means enabling a viewer to access information pertaining to the performance and to the custodian over the network (BayTSP: page 9, “2257Brans”).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 2, 4-5, 8-9, 11-15, 17-19, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over BayTSP (PTO-892, Ref U) in view of Barone (U.S. Patent Application Number 2003/0051238).**

Referring to claim 1. BayTSP discloses a method of producing media, the media being transmitted over a network, the media being subject to a record-keeping requirement, the method comprising the steps of:

- i) providing information pertaining to media in accordance with a record-keeping requirement (BayTSP: page 8, "BayTSP.com's 2257 suite of products requires customers to submit personally identifiable information about adult entertainment performers in order to comply with federal recording keeping compliance regulations set forth by 18 U.S.C. 2257."),
- ii) associating the information with the media performance (BayTSP: page 8, "BayTSP.com's 2257 products embed 2 forms of identification for each performer in each image.") by storing the information together with an identification of the performance in a storage medium independent of a medium used to transmit the performance (BayTSP: page 8, "...unless it is

a content owner with smart card access to the database where full identification card information is available.”),

- iii) providing the stored associated information to a custodian (BayTSP: page 12, “2257Custodian is a service for web masters who are required to comply with U.S. Code 2257 by maintaining compliance documentation for every performer depicted on a site containing sexually explicit material.”), and
- iv) transmitting the media over a network (BayTSP: page 12, “online content.”),

BayTSP does not expressly disclose a method of producing a live performance, the live performance being transmitted over a network, the live performance being subject to a record-keeping requirement.

Barone discloses a method of producing a live performance, the live performance being transmitted over a network, the live performance being subject to a record-keeping requirement. Barone is directed to a system for embedding in a video program, content ratings, content advisories, demographic information, and other types of record keeping requirements. The video source **10** provides live or recorded video programs to the encoder for embedding data into the video program (Barone: paragraph 0018). Once encoded the video source **10** is transmitted over a serial or network link **36**, such as for example, a local area network (LAN) or wide area network (WAN) link.



At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP to have included the teachings of Barone as discussed above in order to allow a viewer to experience an enhanced television program (Barone: paragraph 0004).

Referring to claim 2. BayTSP further discloses a method wherein the media is transmitted over a computer network to a viewer (BayTSP: page 12, "The United States Federal Government has established practices relating to the use and/or maintenance of particular types of online content.").

Referring to claim 4. BayTSP further discloses a method wherein step (iv) is performed only after the completion of step (iii) (BayTSP: page 12, "BayTSP.com will maintain a database of their site's content that has been pre-screened by a BayTSP.com partner to confirm that is legally compliant.").

Referring to claim 5. BayTSP further discloses a method wherein prior to step (iv) the viewer provides to a site that controls transmission of the media verification that the viewing of the media is legally permissible at the viewer's physical location (BayTSP: page 11. "2257Filter").

Referring to claim 8. BayTSP discloses a method of producing media, the media being transmitted over a network, the method comprising the steps of:

- i) providing an identification of a performer (BayTSP: page 19, "2257(b)"),

- ii) verifying the identification of the performer (BayTSP: page 19, "2257(b)"),
- iii) providing all names used by the performer other than the performer's legal name when the performer has at least a name other than the performer's legal name (BayTSP: page 19, "2257(b)"),
- iv) providing
  - a) an identification of the performance (BayTSP: page 12), and
  - b) a date of the performance (BayTSP: page 12),
- v) associating the information providing in steps i), iii) and iv) (BayTSP: page 8, "BayTSP.com's 2257 products embed 2 forms of identification for each performer in each image.") by storing the information together with an identification of the performance in a storage medium independent of a medium used to transmit the performance (BayTSP: page 8, "...unless it is a content owner with smart card access to the database where full identification card information is available."),
- vi) providing the stored information associated in step v) to a custodian (BayTSP: page 12, "2257Custodian is a service for web masters who are required to comply with U.S. Code 2257 by maintaining compliance documentation for every performer depicted on a site containing sexually explicit material."), and
- vii) transmitting the performance over a network (BayTSP: page 12, "online content.").

BayTSP does not expressly disclose a method of producing a live performance, the live performance being transmitted over a network, the live performance being subject to a record-keeping requirement.

Barone discloses a method of producing a live performance, the live performance being transmitted over a network, the live performance being subject to a record-keeping requirement. Barone is directed to a system for embedding in a video program, content ratings, content advisories, demographic information, and other types of record keeping requirements. The video source **10** provides live or recorded video programs to the encoder for embedding data into the video program (Barone: paragraph 0018). Once encoded the video source **10** is transmitted over a serial or network link **36**, such as for example, a local area network (LAN) or wide area network (WAN) link.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP to have included the teachings of Barone as discussed above in order to allow a viewer to experience an enhanced television program (Barone: paragraph 0004).

Referring to claim 9. BayTSP further discloses a method wherein the media is transmitted over a computer network to a viewer (BayTSP: page 12, "The United States Federal Government has established practices relating to the use and/or maintenance of particular types of online content.").

Referring to claim 11. BayTSP further discloses a method wherein the identification of the performance is a title or an identification number. (BayTSP: page 8, "birth date").

Referring to claim 12. BayTSP further discloses a method wherein the live performance is performed by a plurality of performers, and wherein steps (i) – (vi) are carried out with respect to each of said plurality of performers (BayTSP: page 19, "Any person to whom subsection (a) applies shall, with respect to every performer portrayed in a visual depiction of actual sexually explicit conduct..."),

Referring to claim 13. BayTSP further discloses a method wherein step (vii) is performed only after the completion of step (vi) (BayTSP: page 12, "BayTSP.com will maintain a database of their site's content that has been pre-screened by a BayTSP.com partner to confirm that is legally compliant.").

Referring to claims 14-15 and 17-19. The limitations of claims 14-15 and 17-19 closely parallel those of claims 8-9 and 11-13. Claims 14-15 and 17-19 are rejected under the same rationale as set forth above in claims 8-9 and 11-13.

Referring to claim 23. The limitations of claim 23 closely parallel those of claim 1. Claim 23 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 25. The limitations of claim 25 closely parallel those of claim 1. Claim 25 is rejected under the same rationale as set forth above in claim 1.

**Claims 3, 6-7, 10, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over BayTSP (PTO-892, Ref U) in view of Barone (U.S. Patent Application Number 2003/0051238) in further view of VideoChat (PTO-892, Ref V).**

Referring to claim 3. BayTSP in view of Barone discloses a method according to claim 2 as indicated supra. Neither BayTSP nor Barone disclose a method wherein the viewer is provided with a statement prior to the transmission of the media, the statement comprising information pertaining to the media in accordance with the record-keeping requirement and a location of the custodian.

VideoChat discloses a method wherein the viewer is provided with a statement prior to the transmission of the media, the statement comprising information pertaining to the media in accordance with the record-keeping requirement and a location of the custodian (VideoChat: page 1 "Record-Keeping Information").

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP in view of Barone to have included the teachings of VideoChat as discussed above because some websites are "not intended to be viewed by minors." (VideoChat: page 1).

Referring to claim 6. BayTSP in view of Barone discloses a method according to claim 5 as indicated supra. Neither BayTSP nor Barone disclose a

method wherein the viewer provides a credit card account number to the site that controls transmission of the live performance.

VideoChat discloses a method wherein the viewer provides a credit card account number to the site that controls transmission of the live performance (VideoChat: page 2, "Click Here to Cancel Your Account Online").

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP in view of Barone to have included the credit card processing means of VideoChat in order to allow a content owner a means to deter the theft and misuse of valuable online content. Furthermore, it is well known in the art, that owners of content provide online access to their content in exchange for some reward, monetary or otherwise.

Referring to claim 7. BayTSP in view of Barone discloses a method according to claim 5 as indicated supra. Neither BayTSP nor Barone disclose a method wherein the viewer is charged a premium prior to step (iv).

VideoChat discloses a method wherein the viewer is charged a premium prior to step (iv) (VideoChat: page 2). Videochat discloses a method wherein a user signs up for a \$2.95 trial access membership. After the trial membership expires, the user can obtain a full price membership subscription.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP in view of Barone to have included the credit card processing means of VideoChat in

order to allow a content owner a means to deter the theft and misuse of valuable online content. Furthermore, it is well known in the art, that owners of content provide online access to their content in exchange for some reward, monetary or otherwise.

Referring to claims 10 and 16. The limitations of claim 10 closely parallel those of claim 3. Claim 10 is rejected under the same rationale as set forth above in claim 3.

Referring to claim 20. The limitations of claim 20 closely parallel those of claims 8 and 10. Claim 20 is rejected under the same rationale as set forth above in claims 8 and 10.



**Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over BayTSP (PTO-892, Ref U) in view of VideoChat (PTO-892, Ref V).**

Referring to claim 21. BayTSP discloses a method of providing a recorded performance to a viewer over a network, the recorded performance being subject to a record-keeping requirement, the method comprising the steps of:

- i) providing to a custodian information pertaining to a recorded performance in accordance with a record-keeping requirement (BayTSP: page 12, "2257Custodian is a service for web masters who are required to comply with U.S. Code 2257 by maintaining compliance documentation for every performer depicted on a site containing sexually explicit material."), the information being associated and stored in a storage medium independent of a storage medium used to transmit the performance (BayTSP: page 8, "...unless it is a content owner with smart card access to the database where full identification card information is available."), and
- iii) transmitting the recorded performance to a viewer over the network (BayTSP: page 12, "online content.").

BayTSP does not disclose a method comprising the step of providing a statement to a viewer over a network prior to the transmission of the recorded performance to the viewer, the statement comprising information pertaining to the

recorded performance and to the custodian in accordance with the record-keeping requirement.

VideoChat discloses a method comprising the step of providing a statement to a viewer over a network prior to the transmission of a recorded performance to a viewer, the statement comprising information pertaining to the recorded performance and to the custodian in accordance with the record-keeping requirement (VideoChat: page 1 "Record-Keeping Information").

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP to have included the teachings of VideoChat as discussed above because some websites are "not intended to be viewed by minors." (VideoChat: page 1).

Referring to claim 22. BayTSP discloses a method of providing a recorded performance to a viewer over a network, the method comprising the steps of:

- i) providing to a custodian
  - a) a verified identification of a performer of a recorded performance (BayTSP: page 19, "2257(b)"),
  - b) all names used by the performer of a recorded performance other than the performer's legal name when the performer has at least a name other than the performer's legal name (BayTSP: page 19, "2257(b)"),

- c) an identification of the recorded performance (BayTSP: page 12), the information being associated and stored in a storage medium independent of a storage medium used to transmit the performance (BayTSP: page 8, "...unless it is a content owner with smart card access to the database where full identification card information is available."), and
  - d) a date of the recorded performance (BayTSP: page 12), and
- iii) transmitting the performance over a network (BayTSP: page 12, "online content.").

BayTSP does not disclose a method comprising the step of providing a statement to a viewer over a network prior to the transmission of the recorded performance to the viewer, the statement comprising information pertaining to the recorded performance and to the custodian in accordance with the record-keeping requirement.

VideoChat discloses a method comprising the step of providing a statement to a viewer over a network prior to the transmission of a recorded performance to a viewer, the statement comprising information pertaining to the recorded performance and to the custodian in accordance with the record-keeping requirement (VideoChat: page 1 "Record-Keeping Information").

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP to have

included the teachings of VideoChat as discussed above because some websites are "not intended to be viewed by minors." (VideoChat: page 1).

***Response to Arguments***

Applicant's arguments filed 10/24/2006 have been fully considered but they are not persuasive.

The Applicant argues that both BayTSP and Barone appear to teach actually embedding various data within a transmission or recording of a performance and neither cited reference appears to disclose or suggest associating performer and performance data and storing the associated data in a storage medium other than the medium used to transmit the performance and then providing the stored associated data to a custodian.

The Examiner notes, page 12 of BayTSP teaches that BayTSP maintains a database of site's content that has been pre-screened by a BayTSP partner to confirm that is legally complaint, i.e., storing associated data in a storage medium (database) other than the medium used to transmit the performance.

**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-272-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MSG  
Primary Examiner  
December 15, 2006



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